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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,982

04/07/2006

Bansi Lal

SMC-PT006

8762

3624 7590 02/18/2009

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EXAMINER

KOSACK, JOSEPH R

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

02/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,982	<b>Applicant(s)</b> LAL ET AL.	
	<b>Examiner</b> Joseph R. Kosack	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-44 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 36-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 25-31 and 33-35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/7/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 25-44 are pending in the instant application.

#### ***Amendments***

The amendment filed on September 11, 2008 has been acknowledged and has been entered into the application file.

#### ***Election/Restrictions***

Applicant's election with traverse of Group I (claims 25-31 and 33-35) along with an election of species in the reply filed on September 11, 2008 is acknowledged. The traversal is on the ground(s) that the compounds have a static core structure and that it would not be a burden on the Examiner to search all of the groups. This is not found persuasive because Applicant's core structure is known in the art. See page 17, line 45 of EP 0655439). Therefore, there is no special technical feature over the prior art. Additionally, search burden is not a consideration under lack of unity.

The requirement is still deemed proper and is therefore made FINAL.

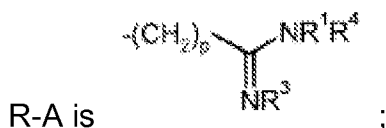
Claims 32 and 36-44 are withdrawn from consideration by the Examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention.

Applicant has made an election of species in the instant case. The search has been broadened in order to cover all compounds of Formula I where:

A is phenyl;

z is N;

W is CH;



p is 0;

all other groups are as defined.

The above group contains a special technical feature over the prior art.

Therefore, the search has been limited to the above group and will not be expanded.

Applicant is encouraged to delete the non-searched subject matter and pursue that subject matter in a divisional application. The non-searched portions of claims 25-31 and 33-35 are withdrawn from consideration by the Examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention.

### ***Priority***

The claim to priority as a 371 filing of PCT/IB04/51922 filed on September 30, 2004, which claims benefit of IN 1054/MUM/2003 filed on October 8, 2003 is acknowledged in the instant application.

### ***Information Disclosure Statement***

The Information Disclosure Statement filed on April 7, 2006 has been considered by the Examiner. The crossed out documents have not been considered as a full copy of the documents has not been provided to the Office as required by 37 CFR 1.98 and MPEP 609.

### ***Claim Objections***

Claims 25-31 and 33-35 are objected to for containing elected and non-elected subject matter. The elected subject matter has been identified above.

***Conclusion***

Claims 25-31 and 33-35 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Kosack whose telephone number is (571)272-5575. The examiner can normally be reached on M-Th 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph R Kosack/  
Examiner, Art Unit 1626